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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Radigon et al. :
Serial No.: 09/341,543 Pd : Group Art Unit: 1714
Filed: February 17, 2000 : Examiner: Szekely, P.

For: **PRESSURE SENSITIVE ADHESIVE WHICH CAN BE APPLIED WHILE HOT**

PETITION TO THE COMMISSIONER UNDER 37 CFR § 1.181,
REQUESTING WITHDRAWAL OF REQUIREMENT FOR
RESTRICTION

Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231

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This is a petition courteously submitted under 37 CFR § 1.181, requesting the Commissioner, through the Honorable Group Director, to instruct the Examiner to withdraw the final requirement for restriction.

Summary:

1. This is a PCT case, whose PCT status was not taken into account in the Requirement, but must be.
2. The claims meet the requirements set forth for unity of invention in Rule 475(a) because the claims relate to the same special technical feature.
3. The claims alternatively even meet the national treatment standard, making the restriction requirement improper.

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Prior History:

The application contains claims 1-23, of which original claims 1-21 were subject to a restriction requirement in the Office Action mailed January 16, 2000. Applicant has maintained traversal of that restriction requirement continuously. Claims 22 and 23, added with the response filed on February 16, 2000, are drawn to the elected invention, despite the holding in the Office Action of May 31, 2001, which made the restriction requirement final and alleged that newly submitted claims 22 and 23 were directed to a non-elected invention.

The Office Action of January 16, 2001 required a restriction since the application allegedly contained two inventions. The Office Action classified claims 1-17, invention I, drawn to a composition, in class 524, subclass 272, and claims 18-21, invention II, drawn to an article, in class 428, subclass 355 AC. The Office Action further stated that the inventions I and II are related as mutually exclusive species in an intermediate-final product relationship, and noted that proving distinctiveness for claims in this relationship requires showing that the intermediate product is useful to make other than the final product (MPEP 806.04(b), 3rd paragraph), or that the species are patentably distinct (MPEP 806.04(h)). The Office Action did not discuss the fact that the current application is a Patent Cooperation Treaty (hereinafter PCT) application, where the unity of invention requirement and not U.S. national rules control whether the claims should be considered together.

The PCT Rules govern the present Restriction Requirement

The current application should have been treated under the rules of the PCT, as it is a national phase application of an International application PCT/FR98/02409 filed November 12, 1998.

U.S. national stage applications filed under 35 USC 371 are subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499 effective May 1, 1993,

while U.S. national applications filed under 35 USC 111(a) are subject to restriction practice in accordance with 37 CFR 1.141-1.146.

The PCT sets out in its rule 13.1 that an “international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (‘requirement of unity of invention’).” See PCT 13.1. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have the right to include in a single application only those inventions which are so linked as to form a single general inventive concept. See MPEP § 1893.03(d), paragraph 5.

The requirement of unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression ‘special technical features’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” 37 CFR 1.475(a).

The requirement of unity of invention under 37 CFR 1.475(a) is fulfilled in the present situation. Claims 1-17 (Group I) are directed toward a composition. Claims 18-23 (Group II) are directed to the same composition of claims 1-17 applied as a layer on a substrate. The two groups thus share the same special technical feature: the presence of the composition of claim 1 in both groups.

MPEP Appendix AI offers examples to guide one in the determination of whether unity of invention exists in a given situation. Both group of claims are directed toward a product, one to a composition and the other to the same composition in the form of a layer on a substrate. Examples 15, 12 and 13 of MPEP Appendix AI illustrate why unity of invention exists in the current situation.

“Example 15

Claim 1: Compound A

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity Exists between claims 1 and 2. The special technical feature common to all the claims is compound A.” MPEP Appendix AI, Example 15.

The presence of the compound A in the second product, the insecticide, satisfied the requirement of unity of invention. The current situation involves a compound which is present in the second product, the layer on a substrate, thus analogously to the example, it satisfies the unity of invention requirement.

“Example 12

Claim 1: A display with features A + B.

Claim 2: A display according to claim 1 with additional feature C.

Claim 3: A display with features A + B with additional feature D.

Unity Exists between claims 1, 2, and 3. The special technical feature common to all the claims is features A + B.” MPEP Appendix AI, Example 12.

The presence of features A + B in all the claims satisfied the unity of invention requirement. Accordingly, the presence of the same composition in both groups of claims in the present invention should as well satisfy the unity of invention requirement.

“Example 13

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having fillament A and a swivel arrangement C.

Unity Exists between claims 1, 2, and 3. The special technical feature common to all the claims is the filament A.” MPEP Appendix AI, Example 13.

Analogously to the example above, where the filament A is viewed as the composition of Group I of the current invention, lamp B having filament A is viewed as the substrate having the composition of Group I, and the searchlight with lamp B having filament A and a swivel arrangement is looked at as a product

with the substrate having the composition of Group I and in a layer arrangement, the unity of invention requirement is thus once again satisfied.

The restriction viewed the two groups of claims as mutually exclusive species in an intermediate-final product relationship. Even if this view is adopted, unity of invention is present in the current application's groups I and II under the standard applicable to national phase applications under PCT Rule 13.2.

The definition of intermediate is intended to refer to an intermediate or starting product. Such products have the ability to be used to produce final products through a physical or chemical change in which the intermediate loses its identity. See MPEP 1850(E). In the current situation the composition in the layer of the composition on a substrate arguably does not lose its identity as required for it to be an intermediate, but assuming that it does, the analysis under the guidance of the same section, MPEP 1850(E), further supports that unity of invention exists in the present invention's Group I and Group II.

“Unity of invention shall be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

- (A) The intermediate and final products have the same essential structural element, in that:
 - (1) The basic chemical structures of the intermediate and the final products are the same, or
 - (2) The chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product; and
- (B) The intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.“ See MPEP 1850(E)

Requirement (A), that the products have the same essential structural element is satisfied by the presence of the composition of Group I in Group II claims. Further defining requirement (A)(1) is satisfied because the basic

chemical structure of the intermediate and final product is the same. In the alternative, even requirement (A)(2) is satisfied because the chemical structures of the two products are technically closely interrelated, so even if it is assumed that some chemical changes occur to the composition when applied to the substrate, the chemical structures of the two products are still technically closely related. Requirement B is also satisfied because the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element. The composition of Group I is directly applied to a substrate to form a layer. Accordingly, even under the intermediate and final products test under the guidelines of the MPEP, the test of unity of invention is satisfied.

The court in Zachariah noted that treatment under the unity of invention concept of the PCT is advantageous when compared to national treatment.

Zachariah v. Comm'r of Patents & Trademarks, 2000 U.S. App. LEXIS 19123, 3 (2000).

Even if U.S. Rules apply, the Restriction is Improper

Applicants maintain that even under the U.S. national standard applied to non-PCT applications, the restriction requirement is improper.

First, it is respectfully submitted that the claims directed to the pressure sensitive adhesive layer (claims 18 plus) produced from the non-reactive pressure sensitive hot melt adhesive composition of claim 1, are related as combination to sub-combination, inasmuch as the layer claims require all of the elements of the composition claims. M.P.E.P. § 806.05(a) defines the combination/sub-combination relationship as a situation where a combination is an organization of which a sub-combination or element is a part. In order to support the Restriction Requirement in such a situation, the M.P.E.P. further holds that the combination must “not require the particulars of the sub-combination as claimed for patentability to show novelty and unobviousness” and the sub-combination must

be shown to have utility either by itself or in different combinations. Arguably, the Examiner has attempted to satisfy the second requirement of this test, in the allegation that the alleged "intermediate product," the adhesive composition, could be used as a raw material for extruded sheeting. The first prong of the test, however, has not been, and cannot be, satisfied. This is because the layer claims require the particulars of the adhesive composition, by their very dependence on the adhesive composition claims.

It should be noted, at this juncture, that it is different to say that the combination "requires the particulars of the sub-combination for patentability", as here, then to say that the combination and sub-combination are not patentably distinct. In the present situation, the combination requires the particulars of the sub-combination, since it recites all the elements of the adhesive composition therein. Since Applicants, of course, do not allege that the mere combination of any adhesive composition applied to a substrate is novel, it can be seen that it is the particular adhesive composition, recited in claim 1, that is used to provide patentability in the layer claims. However, even if the adhesive composition were known *per se* (it is not admitted herein that this is the case) the layer could possess independent patentability if the adhesive were never disclosed in such a utility.

In any event, it is submitted that the two-way distinctness test required in the M.P.E.P. cannot be established since the combination requires all the elements of the sub-combination as discussed above. M.P.E.P. § 806.05(c), under the heading "Sub-Combination Essential to Combination", details the present situation, and states that a restriction "must not" be made, even though the sub-combination has separate utility. This is clearly the case herein, and it is submitted that the M.P.E.P. mandates withdrawal of the Restriction Requirement on this basis alone. Moreover, even if the characterization employed in the Restriction Requirement (species/intermediate-final product) were applicable to the present situation, M.P.E.P. § 803.01 states as follows:

"where plural inventions are capable of viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement."

Thus, it is evident that even if the claims are related as intermediate/final product, the combination/sub-combination requirement must be met as well in order to support the Restriction Requirement. Since it cannot, the Restriction Requirement is improper and should be withdrawn.

It is further noted that added claim 22, also directed to the pressure sensitive adhesive layer, is related to the composition claims in Group I by claim 23, which is in the manner of a linking claim. Claim 23 recites a method for making the adhesive layer of Group II, comprising applying the composition of Group I to the substrate. If the composition of Group I is found allowable, its use is also patentable, see In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996) and In re Ochiai, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995) and M.P.E.P. § 821.04. In such a situation, claim 23 would be rejoined and examined with Group I. However, claim 23 is not only directed to the use of the composition of claim 1, but to the making of the layer of Group II. Thus, this claim links the groups in the manner mandating that the groups be kept together for purposes of examination. It is submitted that this provides further basis to withdraw the Restriction Requirement.

The Examiner in his final rejection alleged that examination of the restricted claims would place extra burden on the examiner. While applicant appreciates that the Examiner prefers to group claims so as to minimize the search burden, mere burden alone is not an officially acceptable reason for making a requirement for restriction. The fact remains that the composition should not be separated from claims targeting the use of such composition. All the claims should be examined together. Moreover, there is no additional burden to examine the non-elected claims. All the elements of the composition claims are present in the restricted claims. If the claims targeting the composition are found allowable,

layers of that same composition applied to a substrate should as well be found allowable. Under long-standing case law, it is *per se* non-obvious to use a thing which itself is not obvious. In re Kuehl, 177 USPQ 250 (CCPA 1973). Furthermore, little if any additional effort would be required by the Examiner in a case as this. The official policy as embodied in MPEP § 803, and the balance of equities, greatly favor withdrawal of the restriction requirement when there is little, if any, additional search burden on the part of the Patent and Trademark Office.

In view of the foregoing, withdrawal of the requirement for restriction is respectfully requested to be ordered.

Respectfully submitted,



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